REMARKS/ARGUMENTS

Claims 22-25, 31-36 were rejected under 35 U.S.C. 102(e) as being anticipated by Assignee's commonly owned patent to Fronk et al (U.S. 6,372,376). In response to Applicant's previous arguments, the Examine takes the position at page 7 of the Office Action that "since the coating mix of Fronk et al is subject to drying and curing, then the coating mix of Fronk et al is uncured and undried when applied as a coating. As such, since the material is applied as coating that must be dried, then the mixture is inherently tacky." However, the Examiner's attention is respectfully directed to independent claim 22 which calls for a method comprising making a current collector for a fuel cell comprising coating an electrically conductive substrate with a tacky layer of uncured or undried material ... and thereafter embedding a plurality of electrically conductive particles in a surface of said layer ... and thereafter curing or drying said layer. Fronk et al does not suggest the separate steps of coating, followed by embedding particles in the surface of the tacky layer, followed by curing or drying. Even if the Examiner has met its burden regarding inherency, which Applicants deny as set forth below, no prima facie case of anticipation under 35 U.S.C. 102 has been established.

Applicants maintain the Examiner has failed to meet his burden of proof regarding the rejections based on inherency. In this regard, the Examiner's attention is respectfully directed to MPEP 2112 IV. The Examiner must provide rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the intrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere

fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-1951 (Fed. Cir. 1999).

At page 3 of the Final Office Action, the Examiner maintains that with respect to claims 23 and 34, Fronk et al teaches the coating can be applied by spraying particles onto the substrate. Citing column 5, lines 21-23. The Examiner acknowledges that Fronk et al does not specifically disclose the spraying pressure of the coating. However, the Examiner provides no evidence or rationale as to why following Fronk et al would necessarily result in spraying particles onto said surface at a pressure greater than 40 psi. Furthermore, Applicant points out to the Examiner that the particles are sprayed onto the surface of the tacky layer whereas Fronk et al teaches spraying a coating on the metal substrate, not the tacky layer.

At page 5 of the Final Office Action, the Examiner takes the position that the recitation in claim 33 that "the particles are present in a higher concentration at the surface than the remainder of the composite" is inherently disclosed in Fronk et al. However, the Examiner fails to provide any evidence or rationale as to why following the disclosure of Fronk et al would necessarily produce a coating wherein the particle concentration is higher at the surface (of the tacky layer) than the remainder of the composite. The Examiner has failed to meet his burden of establishing inherency.

Because the Examiner has repeatedly failed to provide any evidence or rationale to support the numerous inherency positions, no prima facie case of anticipation has been established.

In view of the above remarks, Applicant respectfully requests reconsideration and allowance of all the claims now in the case.

Respectfully submitted,

by 

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